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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,492	05/17/2005	Hyung-Nam Choi	071308.0986 (2003P01541WO	3927

86528 7590 08/21/2009

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EXAMINER	
KASRAIAN, ALLAHYAR	
ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
08/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/535,492	CHOI ET AL.	
	Examiner	Art Unit	
	ALLAHYAR KASRAIAN	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13,15-20 and 22-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13,15-20 and 22-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 May 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/16/2009 has been entered.

Remarks

2. The present Office Action is based upon the Applicant's amendment filed on 06/16/2009. **Claims 13, 15-20 and 22-26** are now pending in the present application.

3. The objections to **claims 18, 16 and 23** are withdrawn. The set of amended claims received on 06/16/2009 is acknowledged by the Examiner.

Response to Arguments

4. Applicant's arguments filed 6/16/2009 have been fully considered but they are not persuasive.

On page 12 through 13 of the Applicant's arguments/remarks with respect to claim 13, Applicant argues, "nowhere in the rejection is it argued that Knauerhase teaches 'establishing *and permitting a connection* to a local wireless network to receive the third party service *based on the stored access information*' as claimed. It appears that the examiner has recognized this difference where it is stated that 'Examiner is

persuaded that the cited portion does not clearly disclose the limitation,' because 'Knauerhas addresses distributing network information, and not authorization of network connections.' *(See* FOA at 3). The failure of Knauerhase to teach *permitting a connection* is underscored by its failure to teach *unique* identification of local area networks. A further premise of the rejection is that col. 3, lines 24-26 and lines 32-27 of Knauerhase disclose uniquely identified local area networks. (FOA at 2). However, this disclosure merely teaches that the mobile device may detect whether service is being provided to the place where the device is located, in other words, the mobile device can detect whether it is getting a signal for particular transceivers. This premise of the rejection fails because this disclose of Knauerhase does nothing to teach or suggest '*permitting a connection . . . based on the stored access information,*' which includes 'a fourth item of network information *uniquely* identifying the local area network.'"

Examiner respectfully disagrees with Applicant for several reason(s). First, Applicant does not recognize the cited portion (indicated by Examiner on the last Office Action) which reads on the claim limitation, where it says "the received connectivity map is consulted and evaluated 610 to see which available of the available connectivity options **identified** by the connectivity map are most desirable. As different network connectivity may have different **restrictions**, costs, etc., for a particular current location of the client there may be less desirable network connectivity. After evaluating available network connectivity, one is selected 612." (See col. 5 lines 10-20). That clearly reads on the claim limitation based on Examiner's interpretation of the claim.

Second, Examiner considers the last two limitations ('a fourth item of network

information uniquely identifying the local area network' and 'establishing a connection to a local wireless network to receive the third party service based on the stored access information') of the broad claim 1 as independent limitations; and does not read, consider, nor interpret the limitations based on Applicant's interpretation by trying to tie the two limitations together.

Third, even by accepting the Applicant's arguments and interpretations of the claim, Knauerhase still discloses the 'authorization of network connections" on col. 4 lines 13-21, where it clearly says, "If 502 a map server is found, a test is performed to determine if 504 sharing is restricted. For example, due to **security, privacy, or other policy** considerations, it might not be desirable for a client to simply dump its entire local connectivity map to the map server, and the client may elect to make available only a portion of its local connectivity map. Thus, if restricted sharing, an appropriate policy or rule is consulted and applied 506, and allowed portions of the client's connectivity map are shared 508" which clearly reads on 'permitting a connection... based on the stored access information' which also includes 'a fourth item of network information uniquely identifying the local area network'.

Therefore, for the reasons stated above, the independent claims 13 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Knauerhase.

The dependent claims 15-19 and 22-25 are rejected at least by the virtue of their dependency on **claims 13 and 20**.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant(s) are remained that the Examiner is entitled to give the broadest reasonable interpretation to the language of the claim. The Examiner is not limited to Applicant's definition, which is not specifically set fourth in the claims, *In re Tanaka et al.* 193 USPQ 139, (CCPA) 1977.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 13 and 20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase).

Consider **claims 13 and 20**, Knauerhase discloses a method for operating

terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network, the second item of identification information comprising (FIGS.1, 3 for items of access information 302, 304 and 306 for how to connect to specific communication standard system, and FIG. 4 for connectivity for transceiver 208, col. 2 lines 10-16 and 44-53, col. 3 lines 27-48; the identification information are inherent with regards to connectivity to a certain item, e.g. the MS will be identified if it can connect to 802.11 or cellular network):

a first item of network information indicating the location of the local area network (col. 3 lines 27-43),

a second item of network information indicating the type of the local area network (FIG. 1 for region/sub-region 802.11 a and/or b, col. 2 lines 10-13 and 23-28 for types of network connectivity, col. 2 line 67-col. 3 line 9 for 802.11a or 802.11b types; FIG 3. for Bluetooth type or 802.11 family type), and

a third item of network information indicating at least one third party service provided by the local area network, wherein the third party service comprises access to one or more applications offered at the location (FIG. 1 for map server(s) 102, col. 2 lines 23-56, map server 102, an regional map servers provide the client global coverage map to inform the client of connectivity options; FIG. 5, col. 4 lines 1-57); and

a fourth item of network information uniquely identifying the local area network (col. 3 lines 27-48; FIG. 5, col. 4 lines 13-21);

requesting a connection to the local wireless network via the terminal (col. 3, lines 21-43);

accessing the stored information (col. 6 lines 45-62); and

establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information (FIG. 6, col. 4 lines 58-59 and col. 5 lines 10-33; FIG. 5, col. 4 lines 13-21).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 15, 16, 22, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase).

Consider **claims 15 and 22 as applied to claim 13 and 20 above respectively**, Knauerhase discloses the claimed invention except the first, second, and/or third items of network information are encoded by means of a maximum of three decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

Consider **claims 16 and 23 as applied to claim 14 and 21 above respectively**, Knauerhase discloses the claimed invention except the fourth item of network information is encoded by means of a maximum of five decimal digits.

Examiner takes an **Official Notice** that the advantages of limiting and

standardizing the size of stored information is well known and expected in the art.

Therefore, it would have been obvious to one ordinary skill in the art to make any kind of restriction on size of encoding data due to the known limited amount of storage on wireless communication devices and to provide a consistent manner of storing this information on the device.

9. **Claims 17-19, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Haverinen et al. (US Patent Application Pub. # 20030119481)** (hereinafter Haverinen).

Consider **claims 17 and 24 as applied to claim 13 and 20 above respectively**, Knauerhase discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at

the time the invention was made to incorporate list of accessible network IDs as taught by Haverinen to the client device memory as disclosed by Knauerhase for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claims 18 and 25 as applied to claim 14 and 20 above respectively**, Knauerhase discloses the claimed invention except the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network.

In the same field of endeavor, Haverinen discloses the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which forbid the operation of the terminal within the local area network (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate list of forbidden network IDs as taught by Haverinen to the client device memory as disclosed by Knauerhase for purpose of authenticating and authorizing a mobile connection to a specific network.

Consider **claim 19 as applied to claim 13 above**, Knauerhase discloses the claimed invention except the at least first item of access information is stored on a device serving for user identification, in particular a USIM module.

In the same field of endeavor, Haverinen discloses the at least first item of access information is stored on a device serving for user identification, in particular a USIM module (par. 0042).

Therefore, it would have been obvious to a person of ordinary skills in the art at the time the invention was made to incorporate a USIM module as disclosed by Haverinen to the client device as disclosed by Knauerhase for purpose of utilizing the network identifiers which are stored for allowing the client to connect to a specific network.

10. **Claim 26** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent # 6941146)** (hereinafter Knauerhase) in view of **Rao et al. (US Patent Application Pub. # 20040076128)** (hereinafter Rao).

Consider **claim 26**, Knauerhase discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication system, and at least one second item of identification information for a local area network, the second item of identification information comprising (FIGS.1, 3 for items of access information 302, 304 and 306 for how to connect to specific communication standard system, and FIG. 4 for connectivity for transceiver 208, col. 2 lines 10-16 and 44-53, col. 3 lines 27-48; the identification information are

inherent with regards to connectivity to a certain item, e.g. the MS will be identified if it can connect to 802.11 or cellular network):

a first item of network information indicating the location of the local area network (col. 3 lines 27-43),

a second item of network information indicating the type of the local area network (FIG. 1 for region/sub-region 802.11 a and/or b, col. 2 lines 10-13 and 23-28 for types of network connectivity, col. 2 line 67-col. 3 line 9 for 802.11a or 802.11b types; FIG 3. for Bluetooth type or 802.11 family type), and

a third item of network information indicating at least one third party service provided by the local area network, wherein the third party service comprises access to one or more applications offered at the location (FIG. 1 for map server(s) 102, col. 2 lines 23-56, map server 102, an regional map servers provide the client global coverage map to inform the client of connectivity options; FIG. 5, col. 4 lines 1-57); and

a fourth item of network information uniquely identifying the local area network (col. 3 lines 27-48; FIG. 5, col. 4 lines 13-21); and

establishing and permitting a connection to a local wireless network to receive the third party service based on the stored access information (FIG. 6, col. 4 lines 58-59 and col. 5 lines 10-33; FIG. 5, col. 4 lines 13-21).

However, Knauerhase fails to disclose the location of the local area network based on a mobile country code that uniquely identifies the country in which the local area network is operated.

In the same filed of endeavor, Rao discloses he location of the local area network

based on a mobile country code that uniquely identifies the country in which the local area network is operated (par. 0024).

Therefore, it would have been obvious to a person or ordinary skill in the art at the time the invention was made to incorporate the IMSI number which is a combination of mobile country code that identifies the country of WLAN operation as taught by Rao to the region where the mobile have connectivity to 802.11 network as disclosed by Knauerhase for purpose of expending the connectivity network on the map server for providing international connectivity map.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

a. Jaakkola et al. (U.S. Patent # 7289807 B2) disclose System and method for using licensed radio technology to determine the operation parameters of an unlicensed radio technology in a mobile terminal

b. Myhre et al. (U.S. Patent Application Publication # 20040203346) disclose System and method for integrating local-area and wide-area wireless networks.

12. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

13. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Allahyar Kasraian whose telephone number is (571) 270-1772. The Examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Rafael Pérez-Gutiérrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

/Allahyar Kasraian/
Examiner, Art Unit 2617

A.K./ak

/Rafael Pérez-Gutiérrez/
Supervisory Patent Examiner, Art Unit 2617

August 17, 2009